

REMARKS

In the Office Action¹, the Examiner rejected claims 8-10 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,578,015 to Haseltine et al. ("*Haseltine*"); rejected claims 1-7 and 14-20 under 35 U.S.C. § 103(a) as being unpatentable over *Haseltine* in view of PR Newswire, "Sun-Netscape Alliance's New Internet Billing Consolidation Application to Help Make Internet Billing a Reality for Consumers" ("*Newswire*"); and rejected claims 11-13 and 21-29 under 35 U.S.C. § 103(a) as being unpatentable over *Haseltine*.

Based on the following remarks, Applicants respectfully traverse the rejections of under 35 U.S.C. §§ 102(e) and 103(a).

I. Regarding the rejection of claims 8-10 under 35 U.S.C. § 102(e) as being anticipated by *Haseltine*

Applicants respectfully traverse the rejection of claims 8-10 under 35 U.S.C. § 102(e) as anticipated by *Haseltine*. In order to properly establish that *Haseltine* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Claim 8 recites a system including:

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

a consolidator module; and
a biller module, connected to the consolidator module,
wherein the biller module includes
biller-independent submodules for communicating with the
consolidator module;
biller-dependent modules for retrieving information from data
stored by the biller; and
an interface enabling the biller-independent submodules to
interact with the biller-dependent submodules

(emphasis added). *Haseltine* does not disclose at least these elements of Applicants' claimed invention.

Haseltine discloses a network 300 "including billers, customers, consolidators and payment processors" (col. 9, lines 49-50). The Examiner states that thick consolidator 350 and thin consolidator 360 correspond to the claimed "consolidator module" and billers 310, 320, and 330 correspond to the claimed "biller module" (Office Action at page 2). Even assuming that this statement is correct, which Applicants do not concede, *Haseltine* does not teach or suggest the claimed "biller-independent submodules" and "biller-dependent submodules," as recited in claim 8.

The Examiner asserts, "thick consolidators maintain databases of accounts related to the various billers" and "thin consolidators access information maintained at the biller sites" (Office Action at page 2). Even assuming that this is correct, which Applicants do not concede, the thick consolidators and thin consolidators do not constitute the claimed "biller-independent submodules" and "biller-dependent submodules" at least because these consolidators reside within the consolidator module, not the biller module as stated by the Examiner and depicted in Fig. 3.

Moreover, any database of records that may exist in *Haseltine* is dependent on billers 310, 320, and 330. All communication between billers 310, 320, and 330 and

thick consolidator 350 and thin consolidator 360 is dependent upon the information contained within the billers. Therefore, *Haseltine* does not teach or suggest “biller-independent submodules for communicating with the consolidator module,” as recited in claim 8.

The Examiner also appears to consider thin consolidator access to information maintained at the biller sites of *Haseltine* as a teaching of the claimed “biller-dependent modules for retrieving information from data stored by the biller” (Office Action at page 2). This is not correct.

Any access of information from the billers by thin consolidator 360 of *Haseltine* occurs at the thin consolidator 360, characterized by the Examiner as corresponding to the claimed “consolidator module” (Office Action at page 2). However, claim 1 recites a “biller module [that] includes . . . biller-dependent modules for retrieving information from data stored by the biller.” Thin consolidator 360 is not located within billers 310, 320, and 330 (See Fig. 3). Therefore, *Haseltine* does not teach or suggest “biller-dependent submodules for retrieving information from data stored by the biller” at least because any retrieval in *Haseltine* occurs by consolidators that are separate from the biller module. Therefore, *Haseltine* does not teach or suggest “biller-dependent modules for retrieving information from data stored by the biller; and an interface enabling the biller-independent submodules to interact with the biller-dependent submodules,” as further recited in claim 8.

Accordingly, *Haseltine* cannot anticipate claim 8. Claims 9 and 10 depend from claim 8 and are thus also allowable over *Haseltine* for at least the same reasons as claim 8.

**II. Regarding the rejection of claims 1-7 and 14-20 under
35 U.S.C. § 103(a) as being unpatentable over *Haseltine* in view of
*Newswire***

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-7 and 14-20 because a *prima facie* case of obviousness has not been established with respect to these claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

A *prima facie* case of obviousness has not been established because, among other things, neither *Haseltine* nor *Newswire*, taken alone or in combination, teach or suggest each and every element recited by Applicant's claims.

Claim 1 recites a method including:

receiving customer registration information, including information
sufficient to identify the customer;
providing the customer identification information to one of the billers
as part of a first request indicating enrollment in the bill
presentment and payment system; and
permitting access by the customer to billing information from the
one of the billers at an unscheduled time.

(emphasis added). *Haseltine* discloses two ways that the customers may register themselves to the bill presentment and payment database. "Customers wanting to view and pay bills may register themselves by accessing an HTML registration page" (col. 8, lines 65-66). "Alternatively, billers may supply the necessary customer information and

enroll or register customers in a batch mode by loading the customer data into an interface provided in the staging area 420 over" http or ftp (col. 8, line 67 - col. 9, line 5). In both enrollment methods disclosed in *Haseltine*, the enrollment data collected or transmitted by the billers in the process is stored within the database. As a result, the customers log onto the system where the database is maintained. For example, in the case wherein the thick consolidator maintains the database, a "customer may log onto an Internet Web site maintained by the thick consolidator" (col. 10, lines 15-17). Because the customers log onto the system where the enrollment data is stored, the customer does not provide identification "information to one of the billers as part of a first request indicating enrollment."

The Examiner cites col. 9, lines 23-27 of *Haseltine* and states "that customers enroll in a system and that each customer has a unique user account including a plurality of biller accounts, one such biller account for each biller from whom the customer receives bills" (Office Action at page 14). Even though customer accounts may correspond to the appropriate billers, there is no teaching in *Haseltine* of "providing the customer identification information to one of the billers as part of a first request." On the contrary, any customer information in *Haseltine* is provided at an HTML registration page or staging area 420 as previously stated. The HTML registration page and staging area 420 are not present within the billers.

The Examiner also cites col. 11, lines 5-14 of *Haseltine* and states, "when further information is needed the consolidator uses a customer specific URL to the biller's website" (Office Action at page 14). *Haseltine* discloses, "the thin consolidator 360 may also maintain a customer-accessible link to the billers 310, 320 to provide the customer

380 with detail bill data, customer service or other customer services” (emphasis added) (col. 11, lines 2-5). Col. 11, lines 5-14 of *Haseltine* provides an example of thin consolidator access to provide a customer with “detailed bill information.” Information is retrieved and provided to the customer. No information is provided to the biller.

Therefore, *Haseltine* does not teach or suggest “providing the customer identification information to one of the billers as part of a first request indicating enrollment in the bill presentment and payment system,” as recited in claim 1.

The Examiner correctly notes that *Haseltine* does not teach “the step wherein the customer is permitted access to the billing information at an unscheduled time” (Office Action at page 4). However, the Examiner relies on *Newswire* to teach this limitation.

Even if the Examiner’s reliance is appropriate, *Newswire* does not cure the deficiencies of *Haseltine*. *Newswire* discloses an internet bill presentment and payment solution. However, *Newswire* does not teach or suggest “providing the customer identification information to one of the billers as part of a first request indicating enrollment in the bill presentment and payment system,” as recited in claim 1.

Accordingly, *Haseltine* and *Newswire* fail to establish a *prima facie* case of obviousness with respect to claim 1, at least because the references fail to teach each and every element of the claim. Claims 2-5 depend from claim 1 and are thus also allowable for at least the same reasons as claim 1.

Independent claim 14, though of different scope from claim 1, recites limitations similar to those set forth above with respect to claim 1. Claim 14 is therefore allowable for at least the reasons presented above. Claims 15-18 are also allowable at least due to their dependence from claim 14.

Claim 6 recites a method including:

receiving, from a requesting IBPP system, a request for information associated with a customer;
retrieving the requested information; and
forwarding the retrieved information to the requesting IBPP system at an unscheduled time.

(emphasis added). The Examiner admits that *Haseltine* does not teach “wherein the retrieved information is forwarded at an unscheduled time” (Office Action at page 6). The Examiner, however, alleges, “[i]t would have been obvious to anyone skilled in the ordinary art [sic] at the time of invention to include the teachings of *Newswire* to the disclosure of *Haseltine* so that a customer can access their account information anytime they choose” (Office Action at page 6). Applicants respectfully disagree.

Newswire does not teach “forwarding the retrieved information to the requesting IBPP system at an unscheduled time,” as asserted by the Examiner. *Newswire* discloses that the billers “can reach customers more than just once a month” (Page 2, paragraph 5). Instead of mailing a bill to a customer at a preset time (e.g. once a month), “the customer can log onto their online banking site to view a summary of bills from their service providers” (Page 2, paragraph 5).

The online banking site of *Newswire* receives bills from the service providers once the billing period ends. When the bills are received, the banking site can post the bills for the customer to view as often as he would like. However, the fact that the bills can reach the customer more than once a month (i.e. allowing the customer to view the bill many times), does not mean that the online banking site receives the information at an unscheduled time. On the contrary, the information is received at the end of the billing cycle and can be viewed or paid by the customer at any time.

In *Newswire*, bill information is forwarded to the online banking site at specific, scheduled time (end of the billing cycle), and the customer view and pay the bill at any time. Customer viewing and payment occurs independent from information forwarding to the banking site. Therefore, *Newswire* does not teach or suggest “forwarding the retrieved information to the requesting IBPP system at an unscheduled time,” as recited in claim 6.

Accordingly, *Haseltine* and *Newswire* fail to establish a *prima facie* case of obviousness with respect to claim 6, at least because the references fail to teach each and every element of the claim. Claim 7 depends from claim 6 and is thus also allowable for at least the same reasons as claim 6.

Independent claim 19, though of different scope from claim 6, recites limitations similar to those set forth above with respect to claim 6. Claim 19 is therefore allowable for at least the reasons presented above. Claim 20 is also allowable at least due to its dependence from claim 19.

**III. Regarding the rejection of claims 11-13 and 21-29 under
35 U.S.C. § 103(a) as being unpatentable over *Haseltine***

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 11-13 and 21-29 because a *prima facie* case of obviousness has not been established with respect to these claims.

Regarding the rejection of claim 11-13, dependent from claim 8, the Examiner states that the system components in *Haseltine* “would have been obvious to execute the disclosed example, yielding a tangible result” (Office Action at page 7). Even assuming that this assertion is true, which Applicants do not concede, *Haseltine* does

not teach or suggest “biller independent submodules for communicating with the consolidator module”, “biller-dependent modules for retrieving information from data stored by the biller,” and “an interface enabling the biller-independent submodules to interact with the biller-dependent submodules,” as recited in claim 8 and required by dependent claims 11-13. Since the cited prior art fails to teach each and every element of claims 11-13, no *prima facie* case of obviousness, based on *Haseltine*, can be established for these claims.

Claim 21 recites a method including:

receiving customer registration information, including information sufficient to identify the customer; and
providing the customer identification information to the biller as part of a request indicating enrollment in the bill presentment and payment system,
wherein the request is provided to the biller in accordance with a bill data exchange protocol.

(emphasis added). As previously stated, *Haseltine* discloses two ways that the customers may register themselves to the bill presentment and payment database. “Customers wanting to view and pay bills may register themselves by accessing an HTML registration page” (col. 8, lines 65-66). “Alternatively, billers may supply the necessary customer information and enroll or register customers in a batch mode by loading the customer data into an interface provided in the staging area 420 over” http or ftp (col. 8, line 67 - col. 9, line 5). In both enrollment methods disclosed in *Haseltine*, the enrollment data collected or transmitted by the billers in the process is stored within the database. As a result, the customers log onto the system where the database is maintained. For example, in the case wherein the thick consolidator maintains the database, a “customer may log onto an Internet Web site maintained by the thick

consolidator” (col. 10, lines 15-17). Because the customers log on the system where the enrollment data is stored, the customer does not provide identification information to one of the billers as part of a first request indicating enrollment.

Haseltine discloses, “the thin consolidator 360 may also maintain a customer-accessible link to the billers 310, 320 to provide the customer 380 with detail bill data, customer service or other customer services” (emphasis added) (col. 11, lines 2-5). Col. 11, lines 5-14 of *Haseltine* provide an example of thin consolidator access to provide a customer with “detailed bill information.” Information is retrieved and provided to the customer. No information is provided to the biller.

Therefore, *Haseltine* does not teach or suggest “providing the customer identification information to the biller as part of a request indicating enrollment in the bill presentment and payment system,” as recited in claim 21. The rejection of claim 21 under 35 U.S.C. § 103(a) based on *Haseltine* is therefore improper.

Independent claim 23, though of different scope from claim 21, recites limitations similar to those set forth above with respect to claim 21. Claim 23 is therefore allowable for at least the reasons presented above. Claims 24-27 are also allowable at least due to their dependence from claim 23.

Claim 22 recites a method including:

receiving, from the requesting IBPP system, a request;
retrieving the billing data based on the request; and
providing the retrieved data to the requesting IBPP system . . .

(emphasis added). The Examiner cites col 10, lines 26-32 of *Haseltine* as a teaching of the claimed “retrieving” and “providing” (Office Action at pages 9-10). Any IBPP system that may exist in *Haseltine* includes the Web site where the customer can view and pay

bills and the thick consolidator 350, at least because the bills cannot be presented and paid without Web site interaction. Col. 10, lines 26-32 of *Haseltine* discloses the customer ability to view and pay bills on the Web site. As stated by the Examiner, the claimed "request" is implied by logging on (Office Action at page 9). However, logging on results in bills displayed on the Web site.

Any "receiving," "retrieving," and "providing" that may exist in the cited portions of *Haseltine* are located within the IBPP system. Any implied request is received by the IBPP system, which also displays the bills for viewing payment. Any "retrieving" and "providing" occurs at the Web site. Even assuming that the steps of "receiving," "retrieving," and "providing" are present, which Applicants do not concede, they occur within the IBPP system. Therefore, *Haseltine* does not teach or suggest "receiving, from the requesting IBPP system, a request" at least because any receiving in the cited portions of *Haseltine* occurs by the IBPP. Moreover, *Haseltine* does not teach or suggest "providing the retrieved data to the requesting IBPP system," as recited in claim 22, at least because any providing in the cited portions of *Haseltine* occurs by the IBPP, and the IBPP does not provide data to itself. The rejection of claim 22 under 35 U.S.C. § 103(a) based on *Haseltine* is therefore improper.

Independent claim 28, though of different scope from claim 22, recites limitations similar to those set forth above with respect to claim 22. Claim 28 is therefore allowable for at least the reasons presented above. Claim 29 is also allowable at least due to its dependence from claim 28.

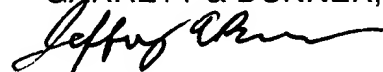
IV. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

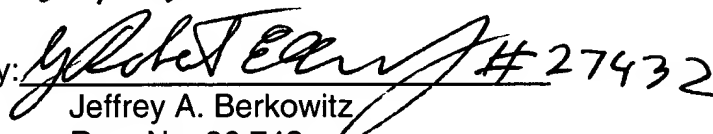
Respectfully submitted,

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Dated: November 22, 2006

By:



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